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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,938	01/22/2004	Nolan D. Schabacker	1043	5975

7590 04/01/2005

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EXAMINER

PECHHOLD, ALEXANDRA K

ART UNIT	PAPER NUMBER
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3671

DATE MAILED: 04/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/762,938

Applicant(s)

SCHABACKER, NOLAN D.

Examiner

Alexandra K Pechhold

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCuskey (US 6,709,191) in view of Palazzotto et al (US 5,822,120).**

Regarding claim 1, McCuskey discloses a method of forming a tactile walking surface structure as part of the prior art in column 1, lines 14-25 and 28-33. McCuskey discloses in the prior art using a pattern of raised markers in a predetermined pattern, which is assumed to be any size of area desired, and the prior art method of drilling holes, inserting markers with elongate pins sticking out for the bottom, and using an adhesive for bonding the pin to the holes. Examples of such pins are seen in the figures of McCuskey, wherein the upper end head portion of the pins have a greater diameter than the diameter of the shank of each of the pins. Inherently, the holes each will have a diameter less than the diameter of the upper end head portions of the pins, and the upper head portion is resting on the upper surface of the concrete slab.

McCuskey fails to specifically disclose the size of the area, or the exact spacing of holes. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the size of the area to be at least 1ft in width by at

least 2ft in length, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

McCuskey also fails to disclose using a template for determining the location of the holes in the upper surface of the slab of the walkway and then drilling the holes in the slab in the pattern of the template. Palazzotto teaches using a random pattern of holes punched into paper stock to act as a template, then laying the template over an aluminum panel and applying adhesive, *forming a discrete pattern of adhesive*, then applying the retroreflective elements to the adhesive (Example 8 in Col 15, lines 45-51). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the prior art method disclosed in the background of McCuskey to include using a template for determining the location of the holes in the upper surface of the slab of the walkway as taught by Palazzotto, and then drilling the holes in the slab, since Palazzotto states in column 15, lines 45-51 that using a template to create holes where roadway elements are then placed in those holes creates a discrete pattern for placing those roadway elements.

Regarding claims 2 and 3, McCuskey fails to specifically disclose the size of the area, or the exact spacing of holes. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the size of the area to be at least 2ft in width by at least 3ft in length, and have holes in a repetitive square pattern as recited in claim 3 with the pins projecting upwardly 0.20 inches from the upper surface of the concrete, since it has been held that where the general conditions of a

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claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Regarding claim 4, McCuskey disclose a truncated dome shape in column 1, lines 14-25.

3. Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCuskey (US 6,709,191) and Palazzotto et al (US 5,822,120) as applied to claim 4 above, and further in view of Foster et al (US 2,321,476).

Regarding claims 5 and 7, the combination of McCuskey and Palazzotto fails to disclose that each of the markers has a compressive strength substantially equal to or greater than the compressive strength of the slab, and fails to disclose the material of the markers. Foster teaches markers that are traditionally made of metal and cement (Col 1, lines 44-46). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the material of the markers of McCuskey to be made of metal or cementitious material as taught by Foster, and have each of the markers have a compressive strength substantially equal to or greater than the compressive strength of the slab, since Foster notes in column 1, lines 44-46 that such road markers have traditionally been made of such materials, which are well known as readily available and economical, and a compressive strength equal to or greater than the slab would be desirable to maintain the integrity of the markers throughout their wear.

Regarding claims 6 and 8, McCuskey discloses adhesive in column 1, lines 33-34.

4. **Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over McCuskey (US 6,709,191), Palazzotto et al (US 5,822,120), and Foster et al (US 2,321,476) as applied to claim 8 above, and further in view of Webster (US 1,966, 227).** The combination of McCuskey, Palazzotto, and Foster fails to disclose a reservoir between each hole and the pin inserted into the hole. Webster illustrates such a reservoir in Fig. 5 between the pins and hole (19) circumference, which is filled with a plastic material (Col 2, lines 100-103). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the structure of McCuskey to include a reservoir between each hole and pin as taught by Webster, since Webster states in column 2, lines 100-103 that plastic can be inserted into this space to secure the pin in place in the hole.

Response to Arguments

5. Applicant's arguments filed 1/20/05 have been fully considered but they are not persuasive. The applicant has amended to claim 1 to add limitations regarding the use of a template. The Examiner is rejecting claim 1 using McCuskey in view of Palazzotto, since Palazzotto provides the motivation to use a template in creating a discrete pattern to apply roadway elements to a surface. Palazzotto teaches that using a template to create holes where roadway elements are then placed in those holes creates a discrete pattern for placing those roadway elements (column 15, lines 45-51). Therefore, there is motivation to modify the prior art method discussed in the background in McCuskey

with Palazzotto's teaching of using a template to expedite the creation of a discrete pattern on the surface.

Conclusion

6. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexandra Pechhold whose telephone number is (703) 305-0870. The examiner can normally be reached on Mon-Thurs. from 8:00am to 5:30pm and alternating Fridays from 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas B. Will, can be reached on (703)308-3870. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1113.


Thomas B. Will
Supervisory Patent Examiner
Group 3600

AKP
3/21/05